

Applicant : Rourke, et al.
Appl. No. : 09/664,970
Examiner : Ho, Uyen T.
Docket No. : 702563.46

Remarks

This amendment responds to the Office Action mailed November 10, 2003. By this amendment, claims 1, 9, 10, and 11 are amended. Claims 1, 9-20, 37 and 39 are currently pending.

In the Office Action, the Examiner rejected claims 1 and 9 under 35 U.S.C. 103(a) based on the combination of Cox '758 in view of Martinez et al. '909. The Examiner also rejected claims 1, 9-20, 37 and 39 under 35 U.S.C. 103(a) based on the combination of Lenker et al. (USP 6,024,763) in view of Martinez et al. '909. Applicant respectfully submits that the present amendments overcome each of the asserted bases for rejection, and that the claims define patentable subject matter.

Specifically, as to the first basis for rejection, each of claims 1 and 9 has been amended to recite that the flexible leaflets are deflectable from a closed position to an open position "without exposure to a softening liquid." This distinguishes these claims from the combination of the Cox and Martinez et al. patents. Specifically, the Martinez et al. patent requires a softening liquid, such as a warm saline solution, to facilitate flexing of the section in the distal end portion of the sheath between the weakened areas or slits. (See Col. 4, ll. 44-55). Accordingly, because a limitation of the present claims is not taught or suggested by either of the references cited by the Examiner, there can be no prima facie case of obviousness of the present claims. The claims are therefore allowable.

As to the second basis for rejection, the amendments to claims 1 and 9 set forth in the preceding paragraph serve to distinguish those claims over the combination of Lenker

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and Martinez, just as they distinguish the combination of Cox and Martinez. Claims 1 and 9 are therefore patentable for the same reasons set forth above. In addition, claims 10 and 11 have been amended to recite that the blunt distal edge of the bumper member "engages" the proximal end of the prosthesis for preventing axial displacement of the prosthesis upon retraction of the tubular member. This distinguishes these claims from the structure taught in the Lenker patent, where the helical shaft (35) (see Figure 9A) is attached to runners 42. (See Col. 8, lines 43-54). The runners 42, in turn, radially compress and restrain the graft 10. (Col. 7, lines 31-58). Thus, no member is provided that "engages" the proximal end of the prosthesis, as presently claimed. Once again, because a limitation of the present claims is not taught or suggested by either of the references cited by the Examiner, there can be no prima facie case of obviousness of the present claims. Claims 10 and 11 are therefore allowable.

Claims 12-20, 37, and 39 all depend from claim 11, either directly or indirectly. These claims, therefore, are also patentable for the reasons set forth above.

Finally, as to each of the obviousness rejections asserted by the Examiner, in no case has the Examiner stated a teaching or suggestion from within any of the cited references that would have motivated a person of ordinary skill in the art to combine those references in the manner that the Examiner has done. The Examiner cannot simply identify features described in several disparate references and rely upon those teachings to establish a proper rejection under §103. Doing so constitutes pure (and improper) hindsight, using Applicants' claims as a guide. For this additional reason, the rejections stated in the Office Action should be withdrawn, and all claims allowed.

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CONCLUSION

In view of the foregoing, it is submitted that the claims presented in this application define patentable subject matter to which Applicant is entitled. Accordingly, consideration and allowance of the application is requested.

Respectfully submitted,

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